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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/721,669 | 11/25/2003 | Larry M. Cirjak | BP 7339-06 | 5945 |

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BP America Inc.
Docket Clerk, BP Legal, M.C. 5 East
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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,669

Applicant(s)

CIRJAK ET AL.

Examiner

MICHAEL L. SHIPPEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Claim Rejections - 35 USC § 103¹***

Claims 16-28 are rejected under 35 U.S.C. § 103 as being unpatentable over SENNEWALD (GB 1,266,623) and SENNEWALD (GB 1,266,624) optionally in view of CALCAGNO (USP 3,714,237). The primary references teach the claimed process except oxygen is not introduced in a further inlet. Whether oxygen is mixed with the other reactants prior to introduction into the reaction zone or added separately appears to be merely an arbitrary choice. However, it would be readily apparent to one of ordinary skill in the art the ultimately desired results of all reactants being present in the reactor would be achieved regardless of whether oxygen is fed separately from or together with the ethylene and acetic acid reactants. One would still expect all reactants to undergo the same reaction whether the mixing occurs before the reaction zone or within the reaction zone. Moreover, it was apparently recognized in the acetoxylation art that oxygen can be added separately as suggested in the very similar process of CALCAGNO, note lines 4-9 of column 2. While CALCAGNO is not exactly the same process, it is clear from the reference that it was recognized in the vinyl acetate art that the

¹ The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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oxygen can be supplied separately from the other feeds. No unexpected result is seen for supplying the oxygen separately at the same concentration as suggested in the prior art and applicants do not present any persuasive evidence that their process would afford any expected result when operating at the prior art oxygen feed rates. The claims do not require that the amount of oxygen used to exceed the flammable limits of the feed mixture and read on the amount exemplified in the prior art, note Example 2 of the references uses 8% oxygen which is apparently within the claimed range.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, CALCAGNO clearly shows that in the vinyl acetate manufacturing art it is known that it is unnecessary to combine the feeds prior to entering the reaction zone in very similar processes. CALCAGNO merely states the obvious. While one can point out distinctions between the respective processes such as vapor phase verse liquid phase, there are a variety of similarities. They both use the same reactants, they both afford the same products, they both involve fluidized catalysts system (one catalyst supported on an inert carrier that is fluidized the other having the catalyst suspended in a fluid, both processes use palladium catalysts, etc.). It is considered that the respective

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process are sufficiently similar that one skilled in the art would be familiar with both and one would expect features used in one (such as a separate oxygen feed) could be used in the other.

Double Patenting²

Claims 16-28 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-12 of USP 5,550,281 and claims 1-17 of USP 5,710,318. The claims differ only as to the functional language used to describe the concentration of the oxygen present. However, the concentration of oxygen in the respective claims overlap substantially.

² The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).


A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
August 19, 2004



MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621